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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/096,811	06/12/1998	YU-HAI MAO	ESS.P002	2246

26379 7590 08/09/2004

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EXAMINER
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BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 08/09/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/096,811

Applicant(s)

MAO ET AL.

Examiner

Vincent F. Boccio

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on RCE 5/24/04
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-10 and 16-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-10 and 16-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2616.

**Response to Arguments**

1. Applicant's arguments, against the previous rejection of record, filed 5/21/04, with respect to the rejection(s) of claims 1, 3-10 and 16-28 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made see below

**Specification**

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 1, 3-10 and 16-28 are rejected under 35

U.S.C. 103(a) as being unpatentable over Aotake et al. (US 5,687,160) in view of Yasuda et al. (US 5,999,694) and Terashima et al. (US 5,142,521).

Regarding claims 1, 3-10, Aotake discloses and meets the limitations associated with a method and associated apparatus for switching between browser mode (MENU) and video mode (reproduction) in a standalone CD-ROM system for playing a CD ROM type disk, (col. 1, lines 5-15, "CD-Rom" and col. 5), comprising the steps of:

- selecting within a browser mode, a video for playback (Fig. 20, "selection menu);
- switching from browser to video mode (based on the menu selection, col. 3, lines 45-55, "user selection") and playing the selected from the menu;
- returning to the browser mode to enable the user to resume browsing contents of the disk (col. 24, lines 16-, met the user selecting either, "cancel key ... currently reproduced item is halting and reverting to the previous menu ... the previous menu is not necessarily the directly previous menu", "stop key return to initial state");
- wherein the switching step further comprises the steps of:
  - reserving a portion of a memory (Fig. 2, "6", col. 23, lines 30-40, "playback control information ... routed to the RAM 6"), other than the CD-Rom, storing return information and the starting and end addresses.

Althou it is deemed that the memory holds the start and end data to locate the next desired segment (col. 25, line 65 to col. 26, line 2 or information indicating the end) for locating returns when changing the playback state by the user or to allow the user to effect the playback.

Aotake fails to particularly disclose the start and end addresses (user for playback from the start to the end) and return address in the memory.

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For the record it is well known to store return as well as beginning and ending addresses for information for locating upon a reproduction or a resume function.

Terashima teaches in col. 6, lines 13-20, providing a TOC buffer, for storing the start and end addresses of each piece of information recorded, as additional information, used in reproduction, as taught by Terashima.

Yasuda teaches in col. 6 and abstract, etc....., allowing the user to stop and resumes reproduction using record position memory, using the record position being some sort of address information, reproduction is resumed, as taught by Yasuda.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Aotake by incorporating storing of beginning and end addresses as information for reproduction and to store position information upon stopping allowing a user to resume wherein left off, as taught by Terashima and Yasuda, as being conventional and well known features allowing facilitating reproduction playing a sequence and to resume upon stopping based on stored address information in a memory.

Claims 16-28 recite substantially similar limitations and are analyzed and discussed with respect to the claims addresses above, and further the recited claims read on the combination as applied.

**Contact Fax Information**

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication  
intended for entry)

or:

(703) 308-5359, (for informal or draft  
communications, please label "PROPOSED" or  
"DRAFT")

Hand-delivered responses should be brought to  
Crystal Park II, 2121 Crystal Drive, Arlington,  
VA., Sixth Floor (Receptionist).


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Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
8/3/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER